

The opinion in support of the decision being entered  
today was not written for publication in a law journal  
and is not binding precedent of the Board.

Paper No. 46

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MARC ALIZON, FRANCOIS BARRE SINOUSSI, PIERRE SONIGO,  
PIERRE TIOLLAIS, JEAN-CLAUDE CHERMANN,  
LUC MONTAGNIER, and SIMON WAIN-HOBSON

Appeal No. 2001-0492  
Application No. 08/384,248

REMAND

MAILED

DEC 17 2001

Before, STONER, Chief Administrative Patent Judge,  
HARKCOM, Vice Chief Administrative Patent Judge, and  
WILLIAM F. SMITH, Administrative Patent Judge.

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

WILLIAM F. SMITH, Administrative Patent Judge.

REMAND TO EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and take appropriate action.

The examiner entered an examiner's answer on December 20, 1999 (Paper No. 42). Therein, the examiner refers the reader to Paper Nos. 31 and 34 for a statement of the rejection. In the portion of the examiner's answer headed "Response to Argument"

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the examiner only states "All issues raised by appellants have been fully responded to."

The examiner's answer is manifestly improper.

First, it is improper for an examiner to incorporate more than one paper in the examiner's answer. See MPEP § 1208, ("An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action.").

Second, appellants are entitled to an examiner's answer which sets forth in detail why the arguments presented in the Appeal Brief are not persuasive. Furthermore, this board serves as a board of review. 35 U.S.C. § 6(b). The examiner's answer entered in this case does not allow reasoned review of the facts and reasoning relied upon by the examiner in support of the decision that the claims on appeal are unpatentable.

The Reply Brief makes note of the fact that the examiner did not respond to appellants' arguments contained in the Appeal Brief. The examiner entered the Reply Brief without comment and forwarded the case to the Board for a decision. (Paper No. 45, May 5, 2000).

Upon return of the application, the examiner is to review all arguments presented in the Appeal Brief and the Reply Brief and prepare an appropriate communication setting forth the examiner's reasoned response to appellant's position on appeal. It would be particularly helpful if the examiner would also restate the rejection in that Office action instead of making reference to previous papers. Appellants and the board

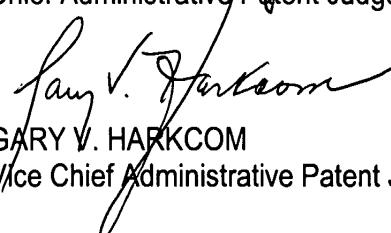
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should not be left to surmise and conjecture as to the examiner's position on appeal,  
including the examiner's response to appellant's arguments.

If otherwise appropriate, we authorize a supplemental examiner's answer under  
37 CFR § 1.193 (b)(1).

This application, by virtue of its "special" status, requires an immediate action.  
MPEP § 708.01(D)(Rev. 1, Feb. 2000) It is important that the board be informed  
promptly of any action affecting the appeal in this case.

REMANDED

  
BRUCE H. STONER, JR.  
Chief Administrative Patent Judge )  
  
  
GARY V. HARKCOM )  
Vice Chief Administrative Patent Judge )  
BOARD OF PATENT  
APPEALS AND  
INTERFERENCES  
  
  
WILLIAM F. SMITH )  
Administrative Patent Judge )

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